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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,404	09/19/2003	Douglas Weldon Carico JR.	71570	8956

7590 10/19/2006

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EXAMINER
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SANDERS, KRIELLION ANTIONETTE

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/666,404

Applicant(s)

CARICO ET AL.

Examiner

Kriellion A. Sanders

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 2-10, 12 and 14-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 11 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-39 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 1, 11 and 13 are under consideration. Applicant's election of Group I, claims 1-17, drawn to a liquid coating composition, and the species of sulfopolyester polymer and anthraquinone blue toner dye in the paper filed 10/28/2005 is acknowledged. Because applicant did not specify the reasons for traversal the election is being treated as an election without traverse. Claims 1, 11 and 13 read upon the elected species. Claims 2-10, 12 and 14-39 are withdrawn as being drawn to a non-elected invention/species. If necessary, search will be extended to determine the patentability of a generic claim.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weaver et al., US Patent No. 4804719 in view of Weaver et al., US Patent No. 5384377, Strand et al., US Patent No 5688899 taken with Kibler et al, US Patent No. 3779993 and Blount et al, US Patent No. 5378757.

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3. Weaver et al '719 discloses water-dispersible polymers, containing colorants as an integral part of the polymer structure. The polymers are useful in adhesives, coating materials, films, packaging materials, and products that can be dissolved or otherwise dispersed in cold or hot water. Aqueous dispersions of the colored polymers have utility as inks, paints, and other coatings where it is advantageous to use aqueous as opposed to organic solvents. The polymer compositions useful in the Weaver compositions are described in U.S. Pat. Nos. 3,734,874, 3,779,993 to Blount, of record and relied upon herein, 3,828,010, 4,233,196, and 3,546,008. These base polymers are defined as water-dispersible polymeric material having linking groups comprising at least about 20 mole % carbonyloxy and up to about 80 mole % carbonylamido. Said material containing water-solubilizing sulfonate groups and having reacted onto or into the polymer backbone from about 0.01 to about 40 mol % based on the total of all reactant hydroxy, carboxy or amino equivalents, of colorant comprising one or more heat stable organic compounds initially having at least one condensable group. Useful colorants for the invention include the carboxy, hydroxy, ester, acid halides, and amino derivatives of such types of compounds as anthraquinones; methines; bis-methines; 3H-dibenz[f,i]isoquinoline 2,7-diones (anthrapyridones); triphenodioxzines; fluoridines; phthaloylpyrrocolines; coumarins; 4-amino-1,8-naphthalimides; thioxanthenes; 2,5-arylaminoterephthalic acids (or esters); benzantrones; and indantrones, etc, wherein said colorants containing at least one condensable group.
4. Weaver et al '377 discloses blue anthraquinones and red anthraquinones or anthrapyridones used in combination to provide a blue hue to polyester resins that are subject to yellowing. Because the components are essentially the same as applicant's, they are expected to

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possess the same absorption properties. See col. 11, line 61 through col. 12, line 56 and claims 1, 2 and Table 11.

5. Strand et al discloses blue anthraquinones and red anthraquinones used in combination to improve the clarity of polyester resins that are subject to yellowing. Because the components are essentially the same as applicant's, they are expected to possess the same absorption properties. See col. 2, line 7 through col. 3, line 7 and Table 1.

6. Kibler et al discloses polyesters that have been modified with a sulfonate metal salt group, and wherein the resulting polymers are useful for forming aqueous coating compositions.

7. Blount, Jr. et al discloses water dissipatable alkyd resins that have been modified with a sulfonate monomer. The resulting resins possess ester groups and are Used for forming coating compositions. The coating compositions may include blue colorants. See col. 7, line 3 through col. 8, line 14.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the blue anthraquinones and red anthraquinones of Weaver et al '377 or Strand et al into the polyester coatings of Weaver et al '719 or Kibler et al or the alkyd coatings of Blount et al. to provide their expected coloring properties. There is nothing unexpected in making such a variation.

1. Applicant argues that the toner systems taught in Weaver and Strand are not water-dispersable. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the toner systems taught in Weaver and Strand are not water-dispersable) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations

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from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant's claims as amended require that the polyester or alkyd polymer be water-dispersible, not that the toner system be water dispersible. Because the polyesters of Weaver are essentially the same as applicant's polyesters, it is believed that they would possess the same properties as applicant's polyesters. Compare the description of the Weaver '377 polyesters at col. 11, line 61 through col. 13, line 3 to the description of applicant's polyesters at page 33, line 20 through page 34, line 17. The acid and glycol reactants and weight ratios of the Weaver '377 reactants are essentially the same as applicant's.

2. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Weaver et al, '719 provides clear incentive for combining water-dispersible polyesters with red and blue toner dyes such as those disclosed by Weaver et al'377.


#### ***Information Disclosure Statement***

Applicant is reminded that any prior art cited on form 1449 must include a month and year of publication to be initialed and signed on form 1449.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kriellion A. Sanders whose telephone number is 571-272-1122. The examiner can normally be reached on Monday through Thursday 8:30am-7:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Kriellion A. Sanders  
Primary Examiner  
Art Unit 1714

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